

# **REMARKS**

## **I. NEW CLAIMS**

New claims 17 to 34 replace canceled claims 1 to 16. The original claims 1 to 16 were English translations of the claims of a German patent document and were not prepared according to the formal rules of the US Patent Office.

Dye composition claims 17 to 27 contain the same subject matter as canceled dye composition claims 1 to 11, but have been put in a form that complies with US Patent Office Rules for claim wording.

Agent claims 28 to 30 contain the subject matter of canceled claims 12, 13, and 2. Agent claim 28 has been drafted as an independent claim including the subject matter of canceled claims 12 and 1.

Method claims 31 to 34 replaced the canceled "use" claims 14 to 16, which are in a form that is not permitted under 35 U.S.C. 101.

## **II. SPECIFICATION AND ABSTRACT**

The abstract has been replaced by an abstract of the disclosure to eliminate legalistic wording such as "present application has for an object". The

new abstract includes the subject matter of the canceled abstract and new claims 17 to 19.

Standard section headings and a cross-reference to the priority document and the international application have been included in the specification by the above changes.

### **III. CLAIM OBJECTION**

Claim 4 was objected to because of improper wording describing alternative preferred embodiments, i.e. improper Markush wording. The suggestions to correct this wording in paragraph 1 on page 2 of the Office Action have been adopted in drafting the new claim 20.

It is respectfully submitted that the wording of the new claims should not be objected to for the reasons in paragraph 1 on page 2 of the Office Action.

### **IV. INDEFINITENESS REJECTION**

Claims 14 to 16 were rejected under 35 U.S.C. 112, second paragraph, for indefiniteness.

Claims 14 to 16 were rejected under 35 U.S.C. 101 for recitation of a “use” without setting forth steps of the method of use.

New method claims 31 to 34 replaced canceled “use” claims 14 to 16.

New independent method claims 31 and 33 each claim a method in which the method step is the step of including or adding the combination of ingredients (a) to (d) to the dye carrier composition or colorant for keratin fibers. This single positive step that is recited in claims 31 and 33 should be enough to overcome the indefiniteness rejection on page 2 of the Office Action.

For the foregoing reasons it is respectfully submitted that new claims 17 to 34 should not be rejected under 35 U.S.C. 101.

For the foregoing reasons it is respectfully submitted the new claims 31 to 34 should not be rejected under 35 U.S.C. 112, second paragraph, for indefiniteness.

## **V. OBVIOUSNESS REJECTION**

Claims 1 to 16 were rejected as obvious under 35 U.S.C. 103 (a) over Pratt, et al (US Published Patent Application 2004/0019982 A1).

New claims 17 to 34 replace canceled claims 1 to 16, but contain the same subject matter as the canceled claims.

New dye carrier composition claim 17 claims a dye composition that contains a special combination of auxiliary ingredients in addition to dye compounds. The purpose of this special combination of ingredients is to provide a dye composition that has a stable nacreous luster (page 1, lines 28 to 32, of the applicants' US specification). The special combination of ingredients that

provides the desired stable nacreous luster is the combination recited in applicants' canceled claim 1 and new claim 17, which is:

- (a) at least one fatty alcohol with 14 to 60 carbon atoms,
- (b) at least one alkanolamide,
- (c) at least one fatty ester, and
- (d) at least one anionic surfactant;

wherein the weight ratio of fatty alcohol to alkanolamide is limited to from 1:4 to 4:1, preferably from 1:1.7 to 2:1. In preferred embodiments of the dye composition the weight ratio of the fatty ester to anionic surfactant is equal to from 1:7 to 7:1.

The result of this combination of auxiliary ingredients is according to page 9, lines 24 to 25, of the applicants' specification a dye carrier composition with "a uniform consistency and" ... "a highly cosmetic nacreous luster effect."

In contrast, Pratt, et al, teaches in paragraph [0135] that their dye compositions can be in any form. Paragraph [0135] states as follows:

**"No particular limitation is imposed on the form of the hair dye composition of the present invention. Examples include powder, transparent liquid, emulsion, cream, gel, past aerosol, and aerosol foam."**

The examples of their compositions on pages 30 to 33 are clear solutions of their inventive dye compounds. No creamy exemplary dye compositions are described in the examples section of this reference.

Pratt, et al, is unrelated to the purpose of the present invention and solves an entirely different problem. Pratt, et al, does not disclose or suggest any dye compositions having a nacreous luster or creamy dye compositions.

Pratt describes and claims new hair dye compositions for dyeing hair bright vivid and lasting colors that contain special azo dye compounds, which are for example wash-fast (see paragraph [0006], claim 1). This lengthy prior art reference discloses many other optional cosmetic additive ingredients in paragraphs [0084] to [0130], which include fatty esters in paragraph [0088], anionic surfactants in paragraphs [0115] and [0116], alkanolamides in paragraphs [0124] and [0125], and fatty alcohols in paragraph [0130].

However the inventive features of the new hair dye compositions of Pratt, et al, depend on the choice of the azo dye compounds of formula  $A-N=N-B$  ([0010]). Preferred azo dye compounds, D-1 to D-118, are disclosed on pages 8 to 23 of US '982. In the Examples section over 50 exemplary dye compositions containing different azo dye compounds are disclosed and the hair colors, which result from dyeing hair with these different compositions and also in some cases results for wash fastness are reported.

However the exemplary dye compositions do not contain any combination of auxiliary ingredients that is similar in any way to the combination according to applicants' claim 17. Furthermore the exemplary dye compositions are all clear solutions. They are not creamy and they do not exhibit a nacreous luster.

Although the Pratt US Patent Application does disclose some of the ingredients that are included in the applicants' combination, it does not disclose any example of a composition including all four ingredients (a) to (d) of the combination of claim 17 that produces the nacreous luster. Also it does not

disclose or suggest that the four ingredients (a) to (d) should be included in a single dye composition.

Paragraphs [0147] to [0150] do disclose a “general formulation” of the composition of Pratt, et al, for the purpose of formulating examples of their dye compositions for testing the various dye compounds to measure the dye colors that they produce and their color-fastness. However the formulation is only general in the sense that it is a recipe for preparing examples of the composition broadly claimed in claim 1 and in paragraph [0009].

According to the generic disclosure in paragraph [0009] their hair dye composition has only a single required ingredient, the special azo dye compound. However embodiments of their dye composition may contain other known direct-dye and/or oxidation dye compounds, as claimed in claim 7. Other conventional additive ingredients, such as water and conditioning agents and the like, may be included according to pages 24 to 30 of the Pratt reference, but these other additive ingredients are plainly optional ingredients that are not individually required in the compositions of Pratt, et al.

The “general formulation” of paragraphs [0147] – [0150] is clearly a very limited species or embodiment of the broadly disclosed dye composition of Pratt, et al, in paragraph [0009]. Certainly this very limited species accidentally happens to be free of cationic surfactants and fatty alcohol alkoxylates, but this is purely unintended in the case of Pratt, et al. One skilled in the art would not find a hint or suggestion of a generic negative limitation that the dye compositions

should be free of fatty alcohol alkoxylates from the disclosure in paragraphs [0147] – [0150].

The “general formula” in paragraphs [0147] – [0150] is not a broad disclosure of their hair dye compositions, but instead is a specific example of their compositions in which the only variable is the choice of preferred azo dye compound. Pratt, et al, clearly does not disclose that all embodiments of their hair dye compositions as broadly disclosed in paragraph [0009] and claimed in their claim 1 are **free of fatty alcohol alkoxylates**.

Pratt, et al, do not disclose or suggest the negative limitation that their dye compositions are **free of fatty alcohol alkoxylates**, as suggested on page 3 of the Office Action. The exclusion of fatty alcohol alkoxylates is an important feature of the applicants’ invention, because it has been suggested that they render hair more permeable to harmful substances and lead to harmful uptake of dye compounds by the body. Thus their exclusion results in a safer hair dye composition according to the third paragraph on page 1 of the applicants’ specification.

Furthermore Pratt, et al, do **not** disclose or suggest that all four types of ingredients should be included in a single embodiment or example of their hair dye composition as broadly disclosed in paragraph [0009]. There are about at least 100,000 different combinations of ways to select four different types of ingredients from the auxiliary ingredients recited on pages 23 to 30 of Pratt, et al, for their dye compositions. Furthermore the general formulation A (specific embodiment) in paragraphs [00147] – [0150] clearly would lead one skilled in the

cosmetic arts away from including the four ingredients (a) to (d) of claim 17 together in their dye compositions because the formulation A does **not** include any fatty alcohol, alkanolamide or fatty ester.

Obviousness rejections of claimed compositions based on prior art disclosures, which are so broad that they encompass a very large number of different compositions of which the claimed compositions are only a very small part and in which the exemplary compositions lead away from the claimed compositions, have often been overturned by the Federal Circuit Court of Appeals (*In re Baird*, 29 USPQ 2<sup>nd</sup> 1550 (Fed. Cir. 1994); *In re Jones*, 21 USPQ2<sup>nd</sup> 1941 (Fed. Cir. 1992); and see MPEP 2144.08). This sort of prior art reference does not reasonably establish a case of *prima facie* obviousness because it provides no guidance for leading one skilled in the art from the very broad generic disclosure to the claimed composition. In fact, it leads away.

The lack of guidance in Pratt, et al, starts with a complete lack of disclosure of the problem that the applicants were trying to solve. The object of the invention is to provide a combination of auxiliary ingredients that will provide a nacreous luster effect to hair dye compositions. Since Pratt, et al, does not disclose this problem how could one be led to the combination of auxiliary ingredients that solves this particular problem?

In addition the reasons on page 4 of the Office Action note that it would be obvious to optimize the amounts of the various dyeing ingredients. However MPEP 2143.03 clearly states that all limitations in a claim must be considered during an analysis under 35 U.S.C. 103 and MPEP 2141. Furthermore MPEP



2144.05 II B. clearly states that it is only obvious under 35 U.S.C. 103 (a) to optimize result-effective variables, i.e. variables that the prior art teaches should be optimized to obtain the desired results.

The applicants' specification on page 1, line 37, to page 2, line 4, teaches that the desired result, a nacreous effect, is obtained when the fatty alcohol to alkaloamide ratio is 1:4 to 4:1. The prior art reference, Pratt, et al, does not identify this ratio as a result-effective variable that can be optimized to improve the nacreous luster effect. Furthermore it does not even identify the problem or teach any way to obtain nacreous luster effects in dye compositions.

With respect to the embodiments of claim 18, note that page 3, lines 8 to 9, of the specification teach that the nacreous luster effect is "unusually beautiful" for the embodiments claimed in claim 18.

With respect to the embodiments of claim 27, Pratt, et al, teaches the opposite from claim 27. Pratt, et al, teach that their dye compositions can contain cationic surfactants in paragraphs [0114] and [0127]. In contrast, claim 27 requires that the dye compositions must be free of monomeric quaternary ammonium compounds and cationic emulsifiers and surfactants.

With respect to claim 27, Pratt, et al, teaches away from the claimed invention and thus cannot be used to establish a case of *prima facie* obviousness. See MPEP 2145 X.

For the foregoing reasons it is respectfully submitted that new claims 17 to 34 should **not** be rejected as obvious under 35 U.S.C. 103 (a) over Pratt, et al (US Published Patent Application 2004/0019982 A1).

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects to put this case in condition for final allowance, then it is requested that such amendments or corrections be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing the case to allowance, he or she is invited to telephone the undersigned at 1-631-549-4700.

Respectfully submitted,

  
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